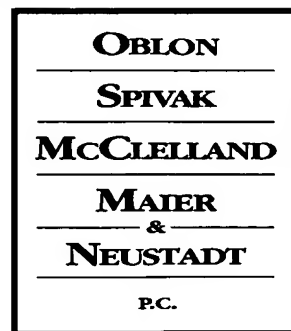




IFW



Docket No.: 219196US0

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 10/067,241
Applicants: Masahide SATO, et al.
Filing Date: February 7, 2002
For: METHOD OF DIFFERENTIATING BEER YEAST
Group Art Unit: 1634
Examiner: SISSON, B. L.

SIR:

Attached hereto for filing are the following papers:

Response to Examiner-Initiated Interview Summary

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Vincent K. Shier, Ph.D.
Registration No. 50,552

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Docket No.: 219196US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Masahide SATO, et al. : EXAMINER: SISSON, B. L.
SERIAL NO.: 10/067,241 :
FILED: FEBRUARY 7, 2002 : ART UNIT: 1634
FOR: METHOD OF DIFFERENTIATING BEER YEAST

RESPONSE TO EXAMINER-INITIATED INTERVIEW SUMMARY

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The Examiner-Initiated Interview Summary mailed to Applicants' undersigned Representative on October 2, 2006, is hereby objected to as not being an accurate reflection of the substance of the discussion of September 25, 2006.

On September 25, 2006, Examiner Sisson contacted the undersigned to discuss the above-identified application. As stated in Examiner-Initiated Interview Summary, Examiner Sisson presented several potential criticisms of the claimed invention and sought for the undersigned to make substantial amendments to the claims that alter the scope and meaning of the claims. Specifically, the Examiner voiced *his* concerns as follows, which appear to be accurately reflected in the Examiner-Initiated Interview Summary:

- a) The Examiner indicated that *he* believes that nature and meaning of the preamble does not reflect the intent of the invention. In particular, the Examiner indicated that it was unclear whether the beer yeasts are being differentiated from one another or from something else.

- b) The Examiner indicated that *he* believes the abbreviation “bp” in defining the length of the primers is misdescriptive as “bp” is an abbreviation for “base pairs”. However, primers are generally single stranded which should be described as “nucleotides” rather than “base pairs”.
- c) The Examiner explained that it is *his* interpretation that Claim 3 encompasses primers that have no similarity to any primer used in the method from which this claim depends due to the phrase “one or more base substitutions”. And,
- d) The Examiner explained *his* interpretation and problems with the claimed method stating that the claimed method does not clearly indicate how one is to differentiate the various amplification products when the amplicons from any given species could have the same size as that derived from any other species. The Examiner further explained that it is *his* position that although the primers are to be from 15-30 nucleotides, the claims fail to stipulate the conditions for annealing. As such, the Examiner explained that *he* believes that the claims encompass annealing conditions where the primers bind to virtually any nucleotide sequence, needing only three or four 3'-terminal nucleotides to anneal for effective priming, thus the remaining nucleotides would not effect priming and, therefore, the resulting amplicon could be from any where in the genome of yeast or from any contaminant. Thus, the Examiner alleged that the claimed invention is not enabled.

In the Examiner-Initiated Interview Summary, the Examiner provides the following statements as to the undersigned's response to the foregoing:

- a) No statement given by the Examiner.

- b) Examiner alleges that "Dr. Shier indicated agreement with this interpretation of primer construction."
- c) Examiner alleges that "Dr. Shier indicated that he would recommend cancellation of this claim." And,
- d) Examiner alleges that "Dr. Shier agreed that significant issues of enablement do exist and requested the Office to prepare a written Office action identifying these issues."

The undersigned disagrees with the foregoing statements and provides the following clarification:

- a) The undersigned acknowledged recognition of the Examiner's concern, agreed to evaluate the same and, *if necessary*, make clarifying amendments.
- b) The undersigned did agree that the abbreviation "bp" represents "base pairs" and that base pairs are generally used to describe the sense:anti-sense pairing rather than adjacent positions in a single strand. The undersigned also agreed that primers are typically single stranded and that "bp" should be replaced with "nucleotides". It is further noted that the single-stranded nature of the primers is consistent with the definition of SEQ ID NO: 7 and SEQ ID NO: 8 at page 11, lines 2-9 of the specification.
- c) The undersigned acknowledged understanding of the Examiner's position and *agreed to consider* amending or canceling Claim 3, *if* it was determined to be appropriate.
- d) The undersigned made no concession that "significant issues of enablement do exist" and certainly does not at this time either. The only indication that the undersigned gave with respect to enablement, *per se*, is to acknowledge that the

Examiner has the aforementioned concerns. No position was taken with respect to the Examiner's conclusion vis-à-vis enablement. Because of the many criticisms raised by the Examiner, the undersigned indicated that further thought and analysis was required than could be adequately addressed through an impromptu telephone conversation. Therefore, as stated in the Examiner-Initiated Interview Summary, the undersigned did request that the Office prepare a written Office action identifying the issues giving rise to the Examiner's enablement concerns, in addition to the other concerns in (a) – (c) above, which would be addressed as appropriate.

Applicants' undersigned Representative attempted to contact Examiner Sisson on October 10, 2006, to discuss the foregoing and to ensure that the Examiner-Initiated Interview Summary mailed October 2, 2006, would be modified to reflect the foregoing. However, the Examiner was out of the Office and, thus, unable to assist.

Respectfully submitted,

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